UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER
DAILEY, THOMAS J

ART UNIT	PAPER NUMBER
2152	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)
	10/627,409	RICHARD ET AL.
	Examiner	**Art Unit**	
	Thomas J. Dailey	2152	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>09 October 2007</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-19* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-19 are pending.

Response to Arguments

2. Applicant's arguments with respect to claims 1-19 have been considered but are moot in view of the new ground(s) of rejection.

3. As the applicant noted in the Response dated October 9, 2007, claims 4-5 and 14-16 were not examined on their merits (vis-à-vis the prior art) by the Office Action dated March 22, 2007, therefore the instant Office Action is non-final.

Claim Objections

4. Claim 6 recites, "a Dynamic Host Control Process" (line 5 and 8-9). It should recite "a Dynamic Host Control *Protocol*."

5. Claim 17 recites, "a IP address" (line 1). It should recite "an."

Specification

6. Applicant is reminded of the proper language and format for an abstract of the disclosure.

    The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. **The**

form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

7. The applicant's abstract is in the form of a claim.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. Claims 1, 6, are 14-17 recite, "Process for...", "Apparatus comprising...", "Router comprising....", or "Printer comprising..." It is unclear if the applicant is referring to "A process..." or "The process..."; "An apparatus..." or "The apparatus..." etc.

11. Claims 2-5, 7-13, and 18-19, recite "Process according to claim..." or "Process for distributing an IP address in accordance with claim..." It is unclear if the applicant is referring to "A process..." or "The process..."

12. Further, claim 6 recites, "completing said process if an answer to said DHCP request is detected during said second duration T2." (lines 18-20) It is unclear what the applicant intends by the phrase "completing said process." Completing in what way? Carrying out the remaining steps? Ending the process?

13. Further, claim 9 recites, "a particular device having a longer experience of the network has a lower time of response." It is unclear what "a lower time of response" means without any context (i.e. in response to what or who) and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

14. Further, claim 14 recites, "Apparatus comprising means for performing the steps of claim 1." A single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under 35 U.S.C. 112, second paragraph. See MPEP 2173.05(p). Claims 15-16 are rejected in a similar manner.

   Additionally, claims 14-16 are not proper dependent claims as they do not further limit their parent claim. Therefore, the Examiner is interpreting these claims as independent claims, and if the Applicant intends to further prosecute

claims 14-16 additional fees are due, as this would give the instant application 6

independent claims, and the applicants have only filed appropriate fees for 3

independent claims. See MPEP 714.10 and 37 CFR 1.16(h).

15. Further, claim 17 recites, "if no answer is received, testing the existence of one

gateway corresponding to one particular set of parameters among said at least

one set of configuration parameters and, **if so**, loading and applying said

particular set of parameters." "If so" lacks antecedent basis and it is unclear what

it refers to.

16. The following lack antecedent basis:

   (a) Claim 5 - "the particular device" (lines 2-3)

   (b) Claim 9 - "the time of operation of said device" (lines 3-4)

   (c) Claim 12 – "the gateway" (line 3)

Claim Rejections - 35 USC § 102

17. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

18. Claims 1-2, 5, 12, 14, and 17-18 are rejected under 35 U.S.C. 102(b) as being

anticipated by Buse et al (UK Patent Published Patent Application, GB 2 356 111

A, submitted in IDS dated March 22, 2007), hereafter "Buse."

19. As to claim 1, Buse discloses process for distributing network configuration

settings throughout a network comprising a set of devices, including the steps of:

establishing in at least one device a description of the network environment

(page 5, lines 1-3, proxy device stores IP address information for a network);

detecting in said at least one device a request for network parameters issued

from a newly connected requesting device (page 5, lines 5-8);

starting a first timer with a first period dependent on a predetermined criterion

(page 5, lines 8-12, proxy device starts a timer when sending out DHCP request);

transmitting to said requesting device network settings in response to the

expiration of said first period unless another one of said set of devices supplies

network settings to said requesting device before the expiration of said first

period (Fig. 3, label 36, and page 5, lines 11-18, IP address is transmitted from

proxy device to new device after time-out).

20. As to claim 17, Buse discloses a process for assigning a IP address in a client

device having at least one configuration file comprising at least one set of

configuration parameters, said process comprising the steps of:

generating and transmitting a Dynamic Host Control Protocol (DHCP) request

to said network (page 5, lines 7-9);

if no answer is received, testing the existence of one gateway corresponding

to one particular set of parameters among said at least one set of configuration

parameters and, if so, loading and applying said particular set of parameters

(page 5, lines 10-27, when no answer is received, proxy device tests for the

existences of IP address that it may give to a newly connected device).

21. Claim 14 is rejected by the same rationale set forth in claim 1's rejection.

22. As to claim 2, Buse discloses the network configuration settings include an

Internet Protocol address and further including a step of testing the availability of

said Internet Protocol address on said network prior to transmitting the network

settings to said requesting device (page 5, lines 16-18).

23. As to claim 5, Buse discloses wherein said predetermined criterion is dependent

on the nature of the particular device where the process is running (page 5, lines

10-13).

24. As to claim 12, Buse discloses distributing a reference of the gateway (page 5,

lines 27-32).

25. As to claim 18, Buse discloses determining a particular context corresponding to

the booting of said device and loading the network configuration settings

corresponding to said context (page 5, lines 5-11).

Claim Rejections - 35 USC § 103

26. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set
forth in section 102 of this title, if the differences between the subject matter sought to be patented and
the prior art are such that the subject matter as a whole would have been obvious at the time the
invention was made to a person having ordinary skill in the art to which said subject matter pertains.
Patentability shall not be negatived by the manner in which the invention was made.

27. Claims 4, 6, 9, 13, 15, and 16 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Buse.

28. As to claim 6, Buse discloses a process for distributing an Internet Protocol (IP)

throughout a network including at least one device comprising a network

parameter allocation (NPAA) agent performing the steps of:

detecting an address request issued by a newly connected requesting device

(page 5, lines 5-8);

starting a first timer, with a first duration T1, in response to the detection of

said address request issued by said newly connected requesting device (page 5,

lines 8-12, proxy device starts a timer when sending out DHCP request, which is

sent out on behalf of the newly connected device);

testing whether a DHCP request received a response from a DHCP server

(page 5, lines 8-12, proxy device waits for a response);

terminating the process in response to the detection of said response within

said first duration (page 5, lines 7-9, proxy device sends DHCP reply to device

and ends process);

computing an IP address (page 5, lines 14-18);

forwarding a DHCP reply containing said computed IP address to said newly

connected requesting device (page 5, lines 7-9, proxy device sends DHCP reply

to device and ends process);.

Buse does not disclose the address request issued by a newly requesting

device is a DHCP request. Rather, Buse disclose the proxy device issues a

DHCP request on behalf of the device after receiving an address request (page

5, lines 5-8). One of ordinary skill in the art would view it as obvious that the 'I

_AM_HERE' address request issued by the newly connected device is the

functional equivalent of a DHCP request, do to the fact it triggers a DHCP

request from the proxy device, and making it so would be a simple substitution.

Further, Bose does not disclose starting a second timer after the expiration of

the first timer that is computed from a set of predetermined criteria. Rather, Buse

discloses one timeout function that accomplishes both of the claimed functionality of claim 6's two timers (page 5, lines 5-18, i.e. after the time-out and no DHCP reply being received, the proxy device calculates and assigns an IP address). Therefore, one of ordinary skill in the art would view a second timer as extraneous.

29. As to claim 4, Buse discloses wherein said predetermined criterion is related to experience gathered by said at least one device (page 5, lines 10-13).

30. As to claim 9, Buse does not explicitly disclose wherein said second duration T2 is computed from the time of operation of said device so that a particular device having a longer experience of the network has a lower time of response.

However, Buse discloses allowing a DHCP server a period of time to reply to a request. Therefore, Official Notice (see MPEP ' 2144.03 Reliance on "Well Known" Prior Art) is taken that adjusting this period of time would have been obvious modification to one of ordinary skill in the art at the time of the invention, as having a flexible timer for differing devices is a common practice in the art and is done in order to increase efficiency and decrease errors.

31. As to claim 13, Buse does not explicitly disclose distributing a booting image to said newly connected requesting device.

However, Official Notice (see MPEP ' 2144.03 Reliance on "Well Known"

Prior Art) is taken that distributing a booting image to a newly connected device is

a common and well-known practice in the art to one of ordinary skill in the art at

the time of the invention, as in any managed network the administrator would like

to have direct control of the managed devices, including their booting procedure.

32. As to claims 15 and 16, Buse does not disclose a router or a printer comprising

means for performing the steps of claim 1.

However, as Buse discloses the allocation of IP addresses to newly

connected devices in a network being aided by a proxy, Official Notice (see

MPEP ' 2144.03 Reliance on "Well Known" Prior Art) is taken it would have been

an obvious modification to one of ordinary skill in the art at the time of the

invention to implement the proxy on a printer or router, as it is well known in the

art that routers and printers can run software such as a proxy in order to manage

a network.

33. Claims 3, 7, and 10-11 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Buse as applied to claims 1 and 6 above, and further in view

of Cole et al. (US Pat. 5,854,901), hereafter "Cole."

34. As to claims 3 and 10, Buse discloses an elaboration of said network

environment is performed via access to Address Resolution Protocol tables in the

network (page 5, lines 17-20).

But, Buse does not disclose an elaboration of said network environment is

performed via access NSLOOKUP tables available in the network as well.

However, Cole discloses an elaboration of said network environment is

performed via access to Address Resolution Protocol tables and NSLOOKUP

tables available in the network (Abstract, lines 10-18 and column 3, lines 44-64).

Therefore it would have been obvious to one of ordinary skill in the art at the

time of the invention to combine the teachings of Buse and Cole in order to utilize

DNS to ensure IP address availability, thus making Buse a more effective system

than just using ARP alone.

35. As to claim 7, Buse discloses the invention substantially with regard to the

parent claim 6, but does not explicitly disclose the second timer is disregarded

when said device is a router.

However Cole discloses handling address assignment for routers differently,

specifically by not utilizing timers (column 3, lines 55-64).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Bose and Cole in order more easily assign IP addresses to routers which make up the back bone of any IP network.

36. As to claim 11, Buse discloses the invention substantially with regard to the parent 6, but does distributing the reference to an existing Hyper Text Transfer Protocol (HTTP) proxy.

However Cole discloses distributing the reference to an existing Hyper Text Transfer Protocol (HTTP) proxy (column 2, lines 28-35).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Buse and Cole in order utilize a widely used protocol to carry out Buse's system.

37. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Buse as applied to claim 6 above, and further in view of Taniguchi (US Pat. 6,928,282).

38. As to claim 8, Buse discloses the invention substantially with regard to the parent claim 6, but does not disclose said second duration T_{sub2} is derived from a

computation of both the Media Access Control (MAC) parameter of said device

and said newly connected requesting device. Rather, all devices are treated the

same and no priority is given to any device when calculating the times.

However, Taniguchi discloses assigning addresses based upon priority

values and this will inherently include time values that are associated with

parameters of the prioritized device (column 8, lines 32-39).

Therefore it would have been obvious to one of ordinary skill in the art at the

time of the invention to combine the teachings of Buse and Cole in order to have

devices that have higher priority (Taniguchi's system) have different time periods

in DHCP server interactions than lower priority devices.

39. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Buse as

applied to claim 17 above, and further in view of Liming (US Pub. No.

2002/0055924).

40. As to claim 19, Buse discloses the invention substantially with regard to the

parent claim 17, but does not disclose said context is determined from the

location of the device, as returned by a GPS receiver.

However, Liming discloses said context is determined from the location of the

device, as returned by a GPS receiver [0014].

Therefore it would have been obvious to one of ordinary skill in the art at the

time of the invention to combine the teachings of Liming and Bose in order more

easy manage IP addresses by utilizes the geographic information of the devices

requesting addresses.

Conclusion

41. Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Thomas J. Dailey whose telephone number is

571-270-1246. The examiner can normally be reached on Monday thru Friday;

9:00am - 5:00pm.

42. If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Bunjob Jaroenchonwanit can be reached on 571-272-3913. The fax

phone number for the organization where this application or proceeding is

assigned is 571-273-8300.

43. Information regarding the status of an application may be obtained from the
Patent Application Information Retrieval (PAIR) system. Status information for
published applications may be obtained from either Private PAIR or Public PAIR.
Status information for unpublished applications is available through Private PAIR
only. For more information about the PAIR system, see http://pair-
direct.uspto.gov. Should you have questions on access to the Private PAIR
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free). If you would like assistance from a USPTO Customer Service
Representative or access to the automated information system, call 800-786-
9199 (IN USA OR CANADA) or 571-272-1000.

TJD
12/17/2007

BUNJOB JAROENCHONWANIT
SUPERVISORY PATENT EXAMINER

12/18/07